

REMARKS

Claims 1-4, 6, 8-12, 14, 16-20, 22 and 24-32 are pending in the present application. Claims 1, 3, 6, 9, 11, 14, 17, 19 and 22 have been amended, Claims 5, 7, 13, 15, 21 and 23 have been canceled, and Claims 25-32 have been added, herewith. Reconsideration of the claims is respectfully requested.

Applicants would initially like to thank the Examiner for taking the time to conduct a telephone interview for the present application. While no agreement was reached, the Examiner stated that how the test/debug script gets generated needs to be further clarified to distinguish over the cited references. Applicants have attempted to comply with this suggestion herewith.

I. Drawings

The Examiner objected to the drawings, stating FIG 1 and FIG 2 should be designated with a Prior Art legend. Applicants are submitting concurrently herewith replacement sheets for FIG 1 and FIG 2 in accordance with this requirement.

II. 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 1, 9 and 17 (and dependent claims thereof) under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. The Examiner states that “said software program executing properly with at least one of a first set of options and executing improperly with at least one of a second set of options” is unclear. This rejection is respectfully traversed.

Applicants have amended such claims to remove this objectionable terminology. Therefore the rejection of Claims 1, 9 and 17 (and dependent claims thereof) under 35 U.S.C. § 112, second paragraph has been overcome.

III. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1-3, 5, 9-11, 13, 17-19 and 21 under 35 U.S.C. § 102 as being anticipated by Borland Turbo Debugger 1991. This rejection is respectfully traversed.

With respect to Claim 1, Applicants show that the cited Borland reference does not teach the claimed generation and comparing of log files. In rejecting Claim 1, the Examiner states that Borland teaches an ability to build a symbol table externally, and that “It is the loading and comparison of the symbol table”, as the Borland reference provides evidence of this comparison when error messages are generated. Applicants respectfully urge that the loading and comparison of the Borland symbol table is substantially different from the claimed log files for at least two reasons. First, the claimed log files are generated by executing the program being debugged (“generating a first log file by executing said program”, the program being the one that is being debugged). In contrast, the Borland symbol table is generated as part of program compilation, and not program execution. Thus, the Borland symbol table does not read on the claimed log file.

Secondly, Borland’s symbols are defined by Borland on page 147 to be “the name of a data object or routine in your program”, and thus a symbol table would be a table of names of such data objects or routines. The log files recited in Claim 1 are not tables of all data objects and routines of a program, but rather is a specific indication of *all functions executed* by the program during actual execution of the program. The symbol table as described by Borland includes a list of all functions in the program, but does not include any type of indicia as to whether or not the functions were actually executed. Applicants have amended Claim 1 to further emphasize the claimed log files with execution status information indicating functions that were actually executed. Borland’s symbol table provides no such execution status, and thus amended Claim 1 is shown to not be anticipated by the cited reference.

In addition, since Borland’s symbol tables are generated prior to program execution, and in particular are generated as part of a (pre-execution) program compilation operation, there would have been no ability to include function execution status as a part of Borland’s symbol table. Thus, there would have been no motivation to modify Borland’s symbol tables in accordance with the invention recited in Claim 1.

Applicants initially traverse the rejection of Claim 2 and 3 for reasons given above regarding Claim 1 (of which Claims 2 and 3 depend upon).

Further with respect to Claim 3, such claim has been amended to include features previously recited in Claims 5 and 7 (with Claims 5 and 7 thus being canceled herewith, without prejudice or disclaimer). As amended, Claim 3 advantageously recites steps of “compiling said software program to generate compiled code, said compiled code including a listing of said functions; generating a file including said listing obtained from said compiled code; and generating a debug script utilizing said file”. The cited reference does not teach such debug script generation, and thus amended Claim 3 is shown to not be anticipated by the cited reference.

With respect to Claim 9 (and dependent Claims 10 and 11) and 17 (and dependent Claims 18 and 19), Applicants traverse for similar reasons to those given above regarding Claim 1.

Further with respect to Claims 11 and 19, Applicants further traverse the rejection of such claims for similar reasons to those given above regarding Claim 3.

Therefore, the rejection of Claims 1-3, 9-11 and 17-19 under 35 U.S.C. § 102 has been overcome.

IV. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 4, 6, 7, 12, 14, 15, 22 and 23 under 35 U.S.C. § 103 as being unpatentable over The Borland Turbo Debugger in view of Shagan (USPN # 6,161,216). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 4, 6, 12, 14 and 22 for similar reasons to those given above regarding their respective independent Claims 1, 9 and 17. As previously mentioned, Claims 7, 15 and 23 have been canceled herewith, without prejudice or disclaimer.

Further with respect to Claims 4, 6, 12, 14 and 22, as stated by the Federal Circuit, “virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate

patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998). "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" See *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). Applicants urge that the use of a compiler option (Claim 4 and 12) or dump command (Claim 6, 14 and 22) to assist in generating a debug script is not taught or suggested by any of the cited references, and thus the only motivation in making the cited reference combination comes from Applicants' own patent application, which is improper hindsight analysis. Thus, the rejection of Claims 4, 6, 12, 14 and 22 is further shown to be in error.

Therefore, the rejection of Claims 4, 6, 12, 14 and 22 under 35 U.S.C. § 103 has been overcome.

V. Newly Added Claims

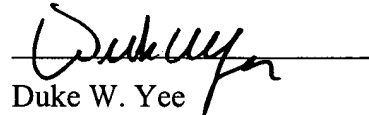
Claims 25-32 have been added herewith. Examination of such claims is respectfully requested.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 8/9/04

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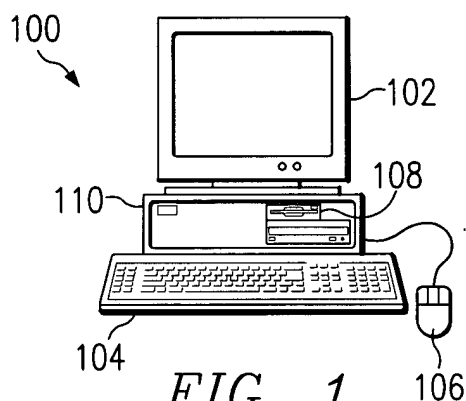


FIG. 1
(PRIOR ART)

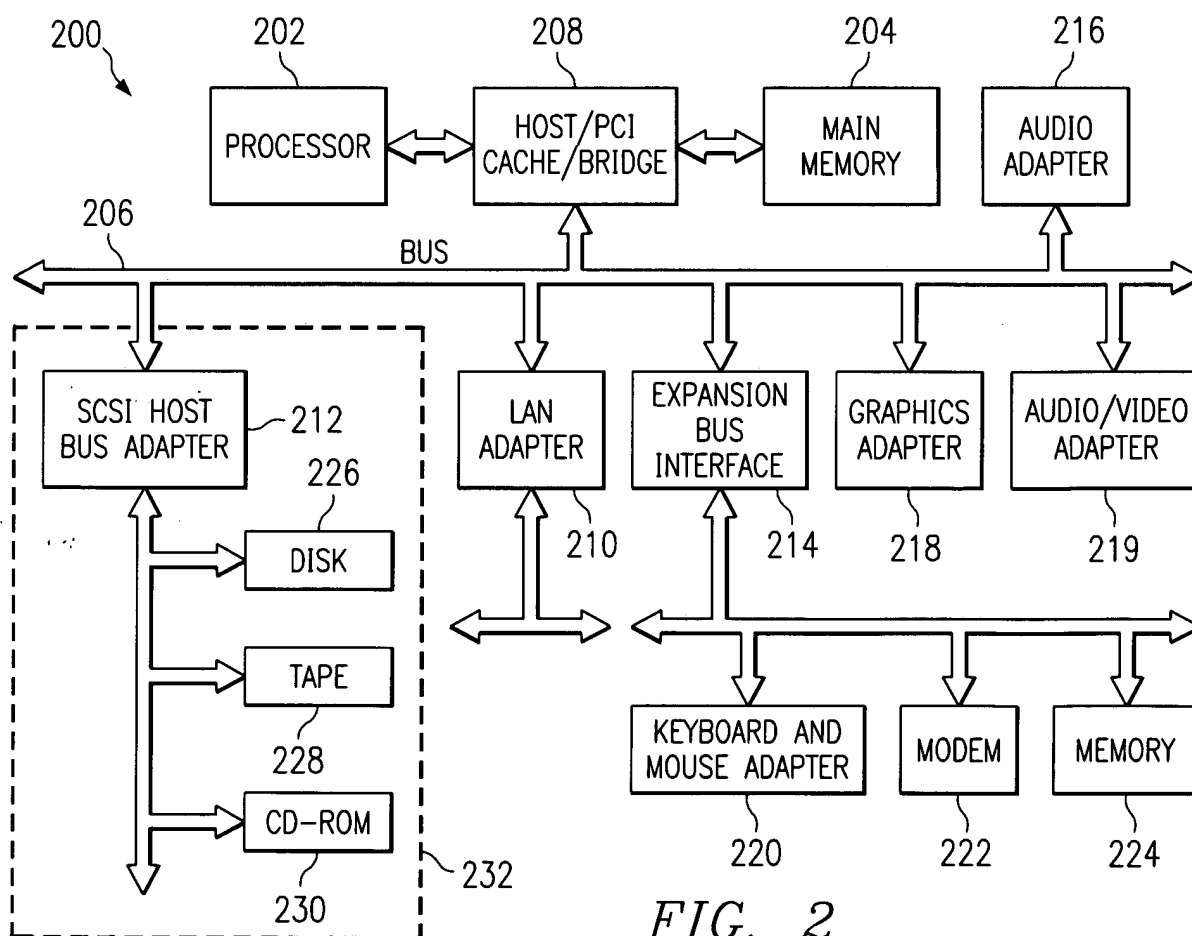


FIG. 2
(PRIOR ART)